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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,771	01/23/2002	John A. Schillinger	N1206-373	7104
6449	7590	02/25/2004	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			PARA, ANNETTE H	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/052,771

Applicant(s)

SCHILLINGER ET AL.

Examiner

Annette H. Para

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Paper submitted on January 16, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-10,13,25,33,35,39,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) 25,33,35,39,42 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Applicant's election without traverse of IV in Paper filed on January 16, 2004 is acknowledged. Applicants' argument that all claims depend on claim 1 is not persuasive because they elected group IV which was plants resistant to glyphosate + glufosinate only. Other inventions are patentably distinct for reasons set forth in previous action. Since original claim 11 was a linking claim, additional inventions may be examined should the elected invention be allowable. The claims are being examined only to the extent that they encompass plants resistant to glyphosate + glufosinate herbicide.

Claims 25, 33, 35, 39, 42, 43 are withdrawn from consideration as drawn to non-elected inventions.

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically:

Claim 13 recites the limitation "the soybean plant". There is insufficient antecedent basis for this limitation in the claim.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,2,4-10,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shankle et al. in view of Barry et al.

Shankle et al. disclose soybean plants resistant to glufosinate herbicide. Shankle et al do not disclose soybean plants resistant to glyphosate herbicide.

Padgett et al. teach soybean seeds and plants that have resistance to glyphosate (page 1452).

Padgett et al. Also teach use of said resistant plant in crosses to produce hybrid soybean plants that are resistant to glyphosate (see page 1455).

It would have been obvious to take the soybean plants having glufosinate resistance of Shankle et al. and the soybean plants having glyphosate resistance of Padgett et al., and to cross them to produce a hybrid plant, using the methods of producing hybrids using each plant, as taught by Padgett. One would have been motivated to do so, given the importance of the value of producing soybean plants that are resistant to herbicides. Since different herbicides are effective against different weeds, one would have been motivated to produce soybeans resistant to multiple herbicides in order to increase the number of weeds which, could be readily controlled in soybean fields. Reasonable expectation of success would have been expected knowing the achievement obtain by Padgett et al. Thus the claimed invention would have been prima facie obvious as a whole at the time it was made, especially in the absence of evidence to the contrary.

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Claims 1,2,4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dyer in view of Padgette et al.

Dyer discloses tobacco plants resistant to glufosinate herbicide and tobacco plants that have resistance to glyphosate (page 46 Herbicide Resistant crops).

It would have been obvious to take the tobacco plants having glufosinate resistance and the tobacco plants having glyphosate resistance, and to cross them to produce a hybrid plant, using the methods of producing hybrids using each plant, as taught by Padgette. One would have been motivated to do so, given the importance of the value of producing tobacco plants that are resistant to herbicides. Since different herbicides are effective against different weeds one would have been motivated to produce tobacco plant resistant to multiple herbicides in order to increase the number of weeds which, could be readily controlled in tobacco fields. Reasonable expectation of success would have been expected knowing the achievement obtain by Padgette et al. Thus the claimed invention would have been prima facie obvious as a whole at the time it was made, especially in the absence of evidence to the contrary.

### **Conclusion**


No claim is allowable.

### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (571) 272-0982. The Examiner can normally be reached Monday through Thursday from 5:30 am to 4:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0994. The fax numbers for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 872-9305.

  
**BRUCE R. CAMPPELL, PH.D**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**